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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/686,433	10/14/2003	W. Todd Daniell	030455; 190250-1580	7279
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EXAMINER				
LAI, MICHAEL C				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/686,433

Applicant(s)

DANIELL, W. TODD

Examiner

MICHAEL C. LAI

Art Unit

2457

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 September 2010.
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 2, 10, 11, 18, 26 and 27 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1, 2, 10, 11, 18, 26 and 27 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 09/29/2010
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____

DETAILED ACTION

This office action is responsive to communications filed on 9/2/2010.

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 9/2/2010 has been entered.

Response to Amendment

The examiner has acknowledged the amended specification, the amended claims 1, 2, 10, 18, 26, the cancelled claims 19, 20, and 25. Claims 1, 2, 10, 11, 18, 26, and 27 are pending.

Applicant has not pointed out where the limitations of the amended claims are supported in the specification. (See MPEP chapter 2163.03 section (I.) and chapter 2163.04 section (I.) and chapter 2163.06) Applicant is requested to provide support for the new/amended claims.

Response to Arguments

Applicant's arguments filed 9/2/2010, with respect to the rejection(s) of claim(s) 1, 2, 10, 11, 18, 26, and 27 under 35 U.S.C. 103(a) have been fully considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 1, 2, 10, 11, 18, 26, and 27 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 recites the limitation "the receiving email message" in line 5. There is insufficient antecedent basis for this limitation in the claim.

Claims 10, 18, and 26 recite the same limitation as claim 1. They are rejected for the same reason as for claim 1.

No Disclosure or Insufficient Disclosure of the Structure, Material, or Acts for Performing the Function Recited in a Claim Limitation Invoking 35 U.S.C. 112, Sixth Paragraph. For claim 18, claim elements "receiving a rule for handling a received email message, the rule defining first criteria and second criteria, the rule further defining an action to be performed when both the first criteria and the second criteria are satisfied by the receiving email message, wherein the first criteria specifies that the received email message is from a given Internet domain and the second criteria specifies that the sender of the received email message is currently present at an instant messaging account", "determining whether the received email message is from the given Internet domain", "determining whether a the sender of a the received email message is currently present at the instant messaging account", "determining whether the sender of the received email message is a contact of a recipient of the received email message",

and “in response to determining that the received email message is from the given Internet domain and the sender of the received email message is currently present at the instant messaging account and in response to determining that the sender of the received email message is the contact of the recipient of the received email message, automatically launching an instant messaging session with the sender” are means (or step) plus function limitation that invokes 35 U.S.C. 112, sixth paragraph. However, the written description fails to disclose the corresponding structure, material, or acts for the claimed functions. There is clearly insufficient disclosure of the Structure, Material, or Acts for Performing the Functions Recited in the Claim.

Applicant is required to:

- (a) Amend the claims so that the claim limitations will no longer be a means (or step) plus function limitation under 35 U.S.C. 112, sixth paragraph; or
- (b) Amend the written description of the specification such that it expressly recites what structure, material, or acts perform the claimed function without introducing any new matter (35 U.S.C. 132(a)).

If applicant is of the opinion that the written description of the specification already implicitly or inherently discloses the corresponding structure, material, or acts so that one of ordinary skill in the art would recognize what structure, material, or acts perform the claimed function, applicant is required to clarify the record by either:

- (a) Amending the written description of the specification such that it expressly recites the corresponding structure, material, or acts for performing the claimed

function and clearly links or associates the structure, material, or acts to the claimed function, without introducing any new matter (35 U.S.C. 132(a)); or

(b) Stating on the record what the corresponding structure, material, or acts, which are implicitly or inherently set forth in the written description of the specification, perform the claimed function. For more information, see 37 CFR 1.75(d) and MPEP §§ 608.01(o) and 2181.

All dependent claims are rejected too as having the same deficiencies as the claims they depend from.

Claim Rejections - 35 USC § 101

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. Claims 10 and 11 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claims 10 and 11 recite the limitation of "computer-readable storage medium" in line 1. The broadest reasonable interpretation of a claim drawn to a computer readable storage medium typically covers forms of non-transitory tangible media and transitory propagating signals *per se* in view of the ordinary and customary meaning of computer readable storage media, particularly when the specification is silent. See MPEP 2111.01. These claims are rejected because the claimed invention is directed to non-

statutory subject matter. Suggestion: use "**non-transitory** computer readable storage medium".

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1-2, 10-11, 18, and 26-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Friskel (US 6,839,737, hereinafter referred to as Friskel), in view of Fang et al. (US 2002/0049961, hereinafter Fang), and further in view of Kirsch (US 2005/0091319 A1, hereinafter Kirsch).

Regarding claim 1, Friskel discloses a method for initiating an instant messaging (IM) session, the method comprising:

determining whether a sender of a received email message is currently present at the instant messaging account [i.e., steps 706, 708] [Fig. 7 and col. 7, lines 31-46];

determining whether the sender of the received email message is a contact of a recipient of the received email message [i.e., step 704, the e-mail address of the sender is compared to the e-mail addresses in contacts file] [Fig. 7 and col. 7, lines 16-30]; and

in response to determining that the sender of the received email message is currently present at the instant messaging account and in response to

determining that the sender of the received email message is the contact of the recipient of the received email message, automatically launching an instant messaging session with the sender [i.e., steps 710, 714] [Fig. 7 and col. 7, lines 47-61].

Friskel discloses substantially the claimed invention except the recipient needs to select "chat." Friskel's invention provides a recipient an option to reply by email or "chat." Once "chat" is selected, it automatically launches an instant messaging session with the sender (see at least Fig. 7 and col. 7, lines 47-61). A person of ordinary skill in the art, upon reading the reference, would also have recognized the desirability of improved methods of automatically launching an instant messaging session with the sender without the extra action of selecting "chat", since the sender is known present at the instant messaging account (i.e., ready for "chat") and is a contact (a trusted person or a buddy) of the recipient. Thus, it would have been obvious to a person with ordinary skill in the art to try automatically launching an instant messaging session with the sender in response to determining that the sender of the received email message is currently present at the instant messaging account and in response to determining that the sender of the received email message is the contact of the recipient of the received email message, as a person with ordinary skill has good reason to do so within his or her technical grasp.

Friskel discloses all the claimed invention except for the limitations: receiving a rule for handling a received email message, the rule defining first criteria and second criteria, the rule further defining an action to be performed when both the first criteria

and the second criteria are satisfied by the receiving email message, wherein the first criteria specifies that the received email message is from a given Internet domain and the second criteria specifies that the sender of the received email message is currently present at an instant messaging account; and determining whether the received email message is from the given Internet domain. However, Fang discloses a "Rule-based personalization framework" permitting the user to define and manage rules and deploy them in a runtime environment. A rule is comprised of a set of condition types and action types. The manager utilizes a set of routines to create new rules or to search for existing rules. The source code of an application or application page will have tags embedded therein for association of the various actions. A rule is thereby deployed by associating certain actions with certain tags within the application [see abstract]. Fang further discloses the Rule Editor 1110 for creating personalization rules by associating an action with one or more user communities, a schedule and a content condition. The Editor will allow rules to be created and named, searched, edited, copied and deleted [see at least para. 0069, 0077]. It would have been obvious to a person with ordinary skill in the art at the time the invention was made to incorporate Fang's teaching into Friskel's method for the purpose of handling a received email message according to defined rules by allowing users to input a condition and an action in response to the condition, thereby processing electronic messages in the most efficient manner.

Friskel and Fang disclose all the claimed invention except for the criteria specifies that the received email message is from a given Internet domain and determining whether the received email message is from the given Internet domain.

However, Kirsch discloses an email filtering method that categorizes received email messages based on information about the sender. Received email is categorized as solicited or unsolicited email by using statistics based on message origin information such as final domain name [see at least the abstract and para. 0011]. It would have been obvious to a person with ordinary skill in the art at the time the invention was made to incorporate Kirsch's teaching into Friskel's and Fang's method for the purpose of filtering unwanted email messages by specifying that the received email message is from a given Internet domain and determining whether the received email message is from the given Internet domain, and in response to determining that the received email message is from the given Internet domain and the sender of the received email message is currently present at the instant messaging account and in response to determining that the sender of the received email message is the contact of the recipient of the received email message, automatically launching an instant messaging session with the sender, thereby processing electronic messages in the most efficient and secure manner.

Regarding claim 2, Friskel further discloses the method of claim 1, wherein determining whether a sender of a received email message is currently present at an instant messaging account includes extracting contact information from the email message, the contact information being associated with the sender of the received email message [i.e., step 706] [col. 7, lines 31-39].

Claims 10-11 are of the same scope as claims 1-2 respectively. They are rejected for the same reason as for claims 1-2 respectively.

Claim 18 is of the same scope as claim 1. It is rejected for the same reason as for claim 1.

Claims 26-27 are of the same scope as claims 1-2 respectively. They are rejected for the same reason as for claims 1-2 respectively.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

Appelman et al. (US 6,912,564 B1) discloses a system for instant messaging the sender and recipients of an e-mail message.

Jenniges et al. (US 6,978,136 B2) discloses a method for automatically initiating a chat session between a user and personnel in the customer support department when the controller indicates that the customer support department is available.

Stewart et al. (US 7,317,928 B2) discloses exposing instant messenger presence information on a mobile device.

Examiner's Note: Examiner has cited particular columns and line numbers in the references applied to the claims above for the convenience of the applicant. Although the specified citations are representative of the teachings of the art and are applied to specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant in preparing

responses, to fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the Examiner.

In the case of amending the claimed invention, Applicant is respectfully requested to indicate the portion(s) of the specification which dictate(s) the structure relied on for proper interpretation and also to verify and ascertain the metes and bounds of the claimed invention.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MICHAEL C. LAI whose telephone number is (571)270-3236. The examiner can normally be reached on M-F 8:30 - 5:00 EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ario Etienne can be reached on (571) 272-4001. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Michael C. Lai
02NOV2010

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